

REMARKS

Although applicant disagrees that claim 1 is indefinite, applicant has none-the-less amended the claim to provide slavish antecedent basis for the term complained of.

Since the amendment to claim 1 overcomes the rejection of such claim as indefinite, it is requested that the amendment be entered for Appeal purposes.

With the above reconsideration of the rejection of claims 1 and 2 over Yoo is respectfully requested.

It is noted that the rejection on Yoo, as it starts out in paragraph 4 of the Office Action, includes the introductory parenthetical expression (as best understood), but the Examiner seems to understand the claimed invention quite well and also seems to understand the distinctions over Yoo.

For example, in the middle of page 3 the Examiner clearly indicates that:

“... Yoo does not explicitly disclose that the second group of connection numbers are below said first group.”

Even that is of course a classic understatement. Yoo, neither explicitly or the implied implicitly, discloses, teaches, or even remotely suggests vertically spaced first and second groups, or the recited upper and lower. The vertically spaced and upper and lower terms aren't found in Yoo and aren't obvious from the single tier girdle of Yoo.

In the rejection on Yoo as obvious, the Examiner relies on two rather old cases as *per se* rules of negative patentability. The Examiner cites *In re Japikse*, 86 USPQ 70 to negate patentability in rearranging parts, and *In re Daily*, 149 USPQ 47 (CCPA 1976) as negating patentability in “change of shape or configuration”.

It is somewhat surprising to see these cases still put forward as authorities since the Federal Circuit has more recently commented on *per se* rules of negative patentability, and that comment seems most appropriate here. In *In re Ochiai*, 37 USPQ 2d 1127 (Fed. Cir. 1995), at page 1133, the Court indicated:

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law

applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an application to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.

The Examiner also criticizes the “adapted to” language with respect to the key protrusion and its relation to the lower connection groove. The limitation is functional but a limitation none-the-less. It’s like reciting a key adapted to fit in a keyhole. Keys that won’t fit aren’t covered. Applicant shouldn’t be required to claim the device assembled and on the pole, thus making an infringing supplier only a contributory or inducing infringer.

The Examiner applies no other reference to applicant’s claims but with the aid of the supposed *per se* rules finds the invention obvious even though the reference doesn’t show the upper and lower limitations, the vertically spaced arrangement, or the claimed limitations of the terminal. This seems admitted and really isn’t in issue.

This situation bring to mind another Federal Circuit decision, *In re Fritch*, 23 USPQ 2d. 1780, 1782 (Fed. Cir. 1992). At page 1783, after quoting the “absent some teaching or suggestion” admonition from *ASC Hosp. Systems, Inc. v. Montifiore*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984), the court goes on to indicate:

“Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.¹⁴ Wilson and Hendrix fail to suggest any modification for, a desirability of, the changes espoused by the Examiner and by the Board.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ (footnotes omitted)

The above language criticized the "pick and choose" process to determine patentability that has often been equated to the utilization of applicants claims as a recipe to construct something from the prior art.

Finally, applicants strongly disagree with the assertion of the Examiner in paragraph 6 of the Office Action that applicants amendments necessitated the new grounds of rejection. This is the usual Final Rejection fiction.

If the Examiner has problems with the wording of the claims a call to the undersigned attorney is suggested.

In the absence of further pertinent art this application is submitted as in condition for final allowance and early action to that effect is respectfully solicited.

Should any deficiencies or overpayments occur in the filing fees of the subject amendment, authorization is hereby given to charge Deposit Account Number 18-0988.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'John W. Renner', is written over a horizontal line.

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